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12/Appeal Brief

Patent
Case No.: 56650US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor:	DUBNER, ANDREW D.		
Application No.:	09/846632	Group Art Unit:	3722
Filed:	May 1, 2001	Examiner:	Willmon Fridie Jr.
Title:	TRANSPARENT TAMPER-INDICATING DATA SHEET		

BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
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CERTIFICATE OF MAILING
I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

15 July 2003 Carolyn V. Peters
Date Signed by: Carolyn V. Peters

Dear Sir:

This is an appeal from the Office Action mailed on February 12, 2003. This Brief is being filed in triplicate. The fee required under 37 CFR § 1.17(c) for the appeal should be charged to Deposit Account No. 13-3723.

REAL PARTY IN INTEREST

The real party in interest is 3M Company (formerly known as Minnesota Mining and Manufacturing Company) of St. Paul, Minnesota and its affiliate 3M Innovative Properties Company of St. Paul, Minnesota.

RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals or interferences.

STATUS OF CLAIMS

Claims 1-24 have been finally rejected.

STATUS OF AMENDMENTS

No amendments have been filed after the final rejection.

SUMMARY OF THE INVENTION

The present invention provides a transparent data sheet wherein a transparent durable film (a first major component), such as polyester or a multilayer optical film (MOF), is adhered to a fragile layer (a second major component), such as a holographic foil or a security laminate, such as Confirm™ Security Laminate, either the fragile sheet or film or the durable film being printed with identification and/or verification information, and includes at least one security feature. The components of the transparent data sheet are laminated together with or without an adhesive layer between the two major components, such that the printed information or image is sandwiched between the two films. The two major components have the same outside dimensions and are congruent.

The term "fragile" as used in this application means a film or material that is mechanically weak and is typically constructed with a removable carrier layer for ease of handling or stability for printing. As used in the application "durable" means a film that is a free-standing film, without the necessity of a carrier layer and is thermally stable to withstand laminating or other processing temperatures, typically in the range of 100 to 150°C, as well as repeated handling, such as typical passport use. Furthermore, both the durable layer and the fragile layer can be constructed to have more that a single component or layer. Additionally, the durable layer could comprise a series of durable and fragile layers. For example, a durable layer could be configured to include a multilayer optical film, an adhesive layer and a second multilayer optical film or a multilayer optical film and a layer of polyester film. Similarly, a fragile layer could be comprised of a holographic foil, a high refractive index layer and a protective coating. These configurations are merely for illustration and do not limit the present invention.

According to one embodiment of the invention, a transparent data sheet is comprised of a multilayer optical film adhered to a fragile layer. Such multilayer optical films may also provide additional security features, such as clear to cyan multilayer optical film described in U.S. Patent No. 6,045,894.

In another embodiment of the invention, a transparent data sheet is comprised of a first fragile layer adhered to a second fragile layer, wherein the laminate of the two fragile sheets is a durable sheet. Advantageously, such a construction could produce a transparent data sheet

comprised of a holographic foil (a first fragile sheet) and a layer of glass beads embedded in a layer of beadbond, such as Confirm™ Security Laminate (a second fragile sheet).

In any of the above embodiments, an optional thin layer of hot-melt adhesive can be used on either the durable or fragile sheet. For example, a hot melt adhesive can be coated onto a holographic foil, the adhesive of which can be printed with any necessary identification indicia, such as names, photographs and the like. Once printed, the holographic foil can be laminated at or above the melt temperature of the hot melt adhesive.

Alternatively, the two layers can be laminated together when one of the layers has a hot meltable surface, such as a multilayered film, wherein one of the surface layers is a low melting point thermoplastic.

Advantageously, the present invention provides a transparent data sheet that contains one or more security features, including but not limited to the destruction of the fragile layer indicating tampering or attempted delamination. Overt security features can include holograms and other diffractive optically variable images, embossed images, and color-shifting films, while covert security features include images only visible under certain conditions such as inspection under light of a certain wavelength, polarized light, or retroreflected light.

In yet another embodiment, a process of manufacturing a transparent data sheet is provided, comprising the steps of (1) printing identification information onto a surface of a first layer and (2) laminating this first layer, printed side to the inside to another film or layer, wherein both layers are optically transparent and one layer is more fragile than the other.

In still another embodiment, a process for manufacturing a transparent data sheet is provided, comprising the steps of (1) providing a printable surface of a first fragile layer, (2) providing a second layer, which is a durable layer or is a fragile layer, with the proviso that combination of the first and second layer provide a durable sheet, and (3) providing instructions for printing and assembling the transparent data sheet.

ISSUES ON APPEAL

1. Whether or not Wang anticipates the claims of the present invention, since Wang is "substantially similar"?

2. Whether or not Wang makes the present invention non-patentable even though the layers are not described and the choice of materials are merely obvious design choices?

GROUPING OF CLAIMS

The appealed claims will stand or fall together. No admission, however, is being made with respect to the obviousness of the subject matter of the dependent claims with respect to the subject matter of the independent claims.

ARGUMENTS OF APPELLANTS

Issue 1: Whether or not Wang anticipates the claims of the present invention, since Wang is "substantially similar"?

Rejection Under 35 U.S.C. § 102(b)

Claims 1, 2, 14, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang. The Examiner alleges Wang discloses all the subject matter as set forth in the claims and is substantially identical to the invention as broadly recited.

Appellants respectfully point out that anticipation requires identity. "The claimed invention, as described in the appropriately construed claims, must be the same as that of the reference in order to anticipate." *Glaverbel Société Anonyme v. Northlake Marketing & Supply Inc.*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Furthermore, "when a claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate." *Mendenhall v. Astec Industries, Inc.*, 12 USPQ2d 1913, 1928 (Tenn. 1988), *aff'd*, 13 USPQ2d 1956 (Fed. Cir. 1989). To date, Appellants have been unable to find any precedent that allows anticipation to stand based on "substantially identical" to the invention.

Appellants understand Wang to disclose an iridescent film overlaid on a substrate member and a filler layer formed beneath the substrate member (column 1, line 37-line 40). The iridescent material is translucent or transparent (column 2, lines 6 and 7). Further, the iridescent material includes a laminated film consisting of a plurality of transparent or translucent thin membranes laminated and superimposed on one another, and outer and inner transparent layers (column 2, lines 19-32). Substrate member and filler layer may be selected from plastic or rubber materials (column 2, line 16 to line 18).

Wang does not disclose a fragile layer as required by Claims 1 and 2 of the present application. Nor does Wang disclose or suggest a transparent layer that is fragile. Appellants have described "fragile" as a mechanically weak material. Wang discloses a 3-D decorative object feature having projections and the overlaid iridescent film by its description cannot be mechanically weak, since it is being used as a layer to prevent scratching. Furthermore, the laminate described in Wang is molded or welded.

Furthermore, Wang does not disclose printed identification or verification information as claimed in Claims 1 and 2. Nor is there any security element in Wang.

Wang fails to disclose a mechanically fragile layer, printed identification or a security element, yet the Examiner states that Wang anticipates because the reference is generally similar to the present invention. Appellants respectfully submit that there is very little similarity other than the cited reference discloses a laminate and the present invention claims a laminate.

Appellants respectfully submit that Wang fails to anticipate the present invention for failure to identically disclose the present invention. In view of the foregoing comments, Appellants respectfully request the Examiner withdraw all 35 U.S.C. § 102(b) rejections from Claims 1, 2 and 14, a claim dependent from Claim 1.

The Examiner has further stated that Wang "inherently teaches the methods of claims 23 and 24."

Appellants respectfully submit that the rejection of claims 23 and 24 is improper. The Examiner has rejected the claims on the basis of 35 U.S.C. § 102(b) on a theory of inherency. However, it is well understood that inherency and obviousness are distinct concepts. That which may be inherent is not necessarily known and obviousness cannot be predicated on what is unknown. *In re Newell*, 13 USPQ2d 1248. 1250 (Fed. Cir. 1989). Therefore, Appellants respectfully submit that which is unknown in Wang (i.e., molding process v. printing process) cannot teach the methods of Claims 23 and 24.

In addition, Claim 23 claims a process for manufacturing a transparent data sheet that includes the step of "(1) providing a printable surface of a first fragile layer". Wang does not disclose a printable surface or a first fragile layer. Further yet, Wang fails to disclose a second fragile layer. A molding process and not a printing process form the decorative items in Wang.

Claim 24 claims a process of manufacturing a transparent data sheet that includes the step of "(1) printing identification information". Wang does not disclose a printing process, but rather a molding process.

Appellants respectfully submit Wang also fails to anticipate Claims 23 and 24. Appellants respectfully request the Examiner withdraw all 35 U.S.C. § 102(b) rejections to Claims 23 and 24.

Issue 2: Whether or not Wang makes the present invention non-patentable even though the layers are not described and the choice of materials are merely obvious design choices?

Rejections under 37 U.S.C. 103(a)

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang. The Examiner alleges Wang discloses the claimed invention except for claimed layer materials. The Examiner asserts it would have been obvious to one having ordinary skill in the art at the time the invention was made to use any suitable material, since it has been held to be within the general skill level of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Appellants respectfully point out that "before obviousness can be established, the Examiner must show that there is either a suggestion in the art to produce the claimed invention or a compelling motivation based on sound scientific principles. Logic compels that the suggestion or motivation be accompanied by a general knowledge of the existence of art-recognized techniques for carrying out the proposed invention." *Ex parte Krantz*, 19 USPQ2d 1216, 1218 (BPAI 1990).

The Examiner has stated that the present invention is obvious over Wang because it would have been obvious to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Appellants respectfully ask the Examiner to be more specific and clarify "suitable for what purpose". The invention taught in Wang is to a decorative 3D article. The present invention is to a security data page. Appellants are unclear how reading Wang teaches Appellants about the present invention. There is no teaching in Wang regarding data pages, fragile hot stamp foils or security elements.

Claim 9 claims the transparent data sheet of Claims 1 or 2 wherein the transparent fragile layer is a multilayered polyurethane film. Claims 10 to 12 claim the transparent data sheet of Claim 1 wherein the data durable film is further defined.

Even if one assumes that it may be obvious to one of ordinary skill in the art at the time the invention was made to use materials of Claims 9 to 12 in the invention of Claim 1, combining the materials of any one of Claims 9 to 12 with the elements disclosed in Wang does not arrive at all of the limitations of these claims. Nowhere does Wang disclose or suggest a transparent fragile layer, printed identification or verification information, or a security element, all elements claims by independent Claims 1 and 2.

Appellants respectfully submit that Wang fails to make the present invention obvious. Thus, Appellants respectfully request the Examiner withdraw all 35 U.S.C. § 103(a) rejections from claims 9 to 13.

Claims 3, 5, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Killey. The Examiner asserts that Wang discloses the claimed invention except for a holographic foil layer, and that Kelley teaches that it is well known in the art to use a holographic foil layer in its assembly. The Examiner also believes it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Wang with a holographic foil layer in the manner as taught by Killey in order to enhance the security feature.

Appellants respectfully submit that in order for the references to be combined, there must be teachings in the reference only if there is some suggestion or incentive to do so. *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Appellants respectfully submit the Examiner has failed to provide any motivation or suggestion to combine the two references. The Examiner states that Wang discloses the invention except for the holographic foil (a statement Appellants firmly believe is in error) and that the holographic foil of Killey can be used in a manner as taught by Killey to enhance the security feature. Appellants submit that Wang does not disclose, teach or otherwise make known a security feature in the description of the 3D decorative article. Without the claims of the present invention serving as a roadmap, there is no incentive to add holographic foil to the article of Wang and there appears to be no security feature in Wang to enhance.

Appellants submit that Wang in view of Killey fails to make the present invention obvious. Furthermore, Appellants submit that Wang alone fails to make the present invention obvious and Killey fails to cure the fatal flaw that Wang does not describe the present invention.

In addition, claims 3, 5 and 18 are dependent claims from Claims 1 or 2, which Appellants believe are allowable in view of the art cited.

Claims 4, 6, 7, 13, 15, 16, 19, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of McConville et al. The Examiner states that Wang discloses the invention except for the retroreflective layer of glass beads (a statement Appellants firmly believe is in error) and that the retroreflective layer of glass beads of McConville can be used in a manner as taught by McConville to enhance the security feature. Appellants submit that Wang does not disclose, teach or otherwise make known a security feature in the description of the 3D decorative article. Without the claims of the present invention serving as a roadmap, there is no incentive to add retroreflective layer of glass beads to the article of Wang and further, there appears to be no security feature in Wang to enhance.

Appellants submit that Wang in view of McConville fails to make the present invention obvious. Furthermore, Appellants submit that Wang alone fails to make the present invention obvious and McConville fails to cure the fatal flaw that Wang does not describe the present invention. In addition, claims 4, 6-7, 13, 15-16, and 19-21 are dependent claims from Claims 1 or 2, which Appellants believe are allowable in view of the art cited.

CONCLUSION

For the foregoing reasons, appellants respectfully submit that the Examiner has erred in rejecting this application under 35 USC §§ 102(b) and 103(a). Please reverse the Examiner on all counts.

Respectfully submitted,

15 July 2003
Date

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APPENDIX

1. A transparent data sheet comprising:

(a) a transparent durable film,

(b) a transparent fragile layer, and

(c) at least one security element

wherein printed identification and/or verification information is sandwiched between the transparent durable film and the transparent fragile layer, and the two layers are laminated together.

2. A transparent data sheet comprising:

(a) a transparent fragile layer,

(b) a second transparent fragile layer, and

(c) at least one security element

wherein printed identification and/or verification information is sandwiched between the two transparent fragile layers, and the two layers are laminated together, with the proviso that the laminate is durable.

3. The transparent data sheet according to claims 1 or 2 wherein the transparent fragile layer is a holographic foil.

4. The transparent data sheet according to claims 1 or 2 wherein the transparent fragile layer is a retroreflective layer of glass beads in a beadbond layer.

5. The transparent data sheet according to claims 1 or 2 wherein the transparent fragile layer is a foil.

6. The transparent data sheet according to claims 1 or 2 wherein the transparent fragile layer is a optical stack.

7. The transparent data sheet according to claims 1 or 2 further including a high refractive index coating, coated on the outer surface of the transparent fragile layer.

8. The transparent data sheet according to claim 7 further including a protective coating, coated on the outer surface of the high refractive index coating.

9. The transparent data sheet according to claims 1 or 2 wherein the transparent fragile layer is a multilayered polyurethane film.

10. The transparent data sheet according to claim 1 wherein the durable film is a multilayer optical film.

11. The transparent data sheet according to claim 10 wherein the multilayer optical film is comprised of at least one material that exhibits stress induced birefringence.

12. The transparent data sheet according to claim 1 wherein the durable film is a polyester, polypropylene, polycarbonate, polyimide, or cellulose acetate.

13. The transparent data sheet according to claims 1 or 2, wherein the transparent fragile layer is comprised of more than one fragile material.

14. The transparent data sheet according to claim 1 wherein the durable film is comprised of one or more durable layers.

15. The transparent data sheet according to claim 2 wherein the second transparent fragile layer is a retroreflective layer of glass beads in a beadbond layer.

16. The transparent data sheet according to claim 1 wherein the transparent durable film is a multilayer optical film and the transparent fragile film is retroreflective layer of glass beads in a beadbond layer.

17. The transparent data sheet according to claim 2 wherein the the transparent fragile film is retroreflective layer of glass beads in a beadbond layer and the second transparent fragile film is a holographic foil.

18. The transparent data sheet according to claim 1 wherein the transparent durable film is a multilayer optical film and the transparent fragile film is a holographic foil.

19. The transparent data sheet according to claims 1 or 2 further including a layer of hot melt adhesive.

20. In combination:

(a) transparent data sheet according to claims 1 or 2, and

(b) a passport, wherein the transparent data sheet is inserted or otherwise attached to the passport.

21. In combination:

(a) transparent data sheet according to claims 1 or 2, and

(b) a document of value, wherein the transparent data sheet is inserted or otherwise attached to the document of value.

22. The combination according to claim 21 wherein the document of value is an identification card.

23. A process for manufacturing a transparent data sheet comprising the steps of:

(1) providing a printable surface of a first fragile layer,

(2) providing a second layer, which is a durable layer or is a fragile layer, with the proviso that combination of the first and second layer provide a durable sheet, and

(3) providing instructions for printing and assembling the transparent data sheet, such that upon assembly, the two layers are laminated together.

24. A process of manufacturing a transparent data sheet comprising the steps of:

(1) printing identification information onto a surface of a first layer and

(2) laminating this first layer, printed side to the inside to another film or layer,

wherein both layers are optically transparent and one layer is more fragile than the other.